MICHAEL P. MARTIN [SBN 190213]
FISCHBACH, PERLSTEIN, LIEBERMAN &
ALMOND, LLP
1925Century Park East, Suite 2050
Los Angeles, California 90067-2746
Telephone: (310) 556-1956
Facsimile: (310) 556-4617
Email: mmartin@fpllaw.com

Attorneys for Plaintiff

IN THE UNITED STATES DISTRICT COURT

FOR THE CENTRAL DISTRICT OF CALIFORNIA

ONPREM SOLUTION PARTNERS, LLC, a Delaware Limited Liability Company, Plaintiff, v. ONPREM, INC. believed to be an Oregon Corporation, and DOES 1-10. Defendants.	Case No.: COMPLAINT FOR FEDERAL TRADEMARK INFRINGEMENT; STATE TRADEMARK INFRINGEMENT; FEDERAL UNFAIR COMPETITION; STATE UNFAIR COMPETITION; FEDERAL TRADEMARK DILUTION; AND STATE TRADEMARK DILUTION

Plaintiff ONPREM SOLUTION PARTNERS, LLC (hereinafter referred to as "Plaintiff") complains and alleges as follows:

JURISDICTION AND VENUE

1. This action arises under the Lanham Act, as amended (15 U.S.C. §§ 1114, 1116, 1117, 1125(a), and 1125(c)); California Business & Professions Code §§ 14320, 14330, 17200, *et seq*., and 17500; and California common law.

Jurisdiction is proper under 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a) and 1338(b). Jurisdiction is also proper pursuant to this Court's supplemental jurisdiction as provided in 28 U.S.C. § 1367 in that the state law claims alleged herein are so related to the federal claims that they form part of the same case or controversy under Article III of the United States Constitution.

2. Venue is proper in this Judicial District under 28 U.S.C. §§ 1391(b) and 1391(c) in that Defendants transact business in this Judicial District and a substantial part of the events or omissions giving rise to the claims herein occurred within this Judicial District.

THE PARTIES

3. Plaintiff ONPREM SOLUTION PARTNERS, LLC ("Plaintiff") is a Delaware Limited Liability Company, having its principal place of business located at 21700 OXNARD STREET SUITE 950, WOODLAND HILLS CA 91367. Plaintiff is the exclusive owner of the trademarks which form the basis of this action.

4. a. Plaintiff is informed and believes, and on such basis alleges, that Defendant ONPREM, INC. (hereinafter individually "Defendant") is believed to be an Oregon Corporation, having a principal place of business at 2951 NW DIVISION ST STE 110, GRESHAM, OR 97030 and is conducting business in California, including this Judicial District and is likewise conducting specific business complained of in this complaint in California, in this Judicial District.

b. Plaintiff is ignorant of the true names and capacities of Defendants sued herein as DOES 1 - 10, inclusive, and therefore sue said Defendants by such fictitious names. Plaintiff will amend this Complaint to allege said Defendants' true names and capacities when ascertained.

c. Plaintiff is informed and believes, and on such basis alleges that each of the aforementioned Defendants acted at all times alleged herein as the agent, employee, representative, and/or alter ego of the other Defendants; is responsible in some manner for the occurrences alleged herein; and caused the injuries alleged herein.

GENERAL ALLEGATIONS
PLAINTIFF AND THE ONPREM MARKS

5. Plaintiff provides information and technology consulting services under its well-known ONPREM trademarks.

6. Plaintiff utilizes its ONPREM trademarks in various combinations in connection with its services, online and in advertising to identify them as originating from Plaintiff.

7. Plaintiff's ONPREM mark is extremely well-known. This high level of name recognition among the public gives this mark lucrative appeal.

8. In addition to the longstanding use and goodwill mentioned above, Plaintiff has registered its ONPREM mark at the United States Federal level. Presently, Plaintiff is the owner of the following U.S. Federally Registered

trademarks: No. 4850382 for the mark ONPREM SOLUTION PARTNERS for the following services:

"Advisory services relating to business management and business operations; Business consultation in the field of electronics, telecommunications, consumer industries, entertainment, media, and retail, about business strategy, change management, process management, organization performance, business technology, and business related policy areas; Business consultation services; Business marketing consulting services; Business project management consulting services, namely, predicting project outcomes and modifying project implementation to increase likelihood of success in business transformation projects; Project management in the fields of information systems design, specification, procurement of computer hardware and software for others in Class 35; and

Consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; Computer software consulting; Consulting services in the design and implementation of computer-based information systems for businesses; Computer hardware and software design; Information technology consulting services; Technical consulting in the fields of computer-based information systems and components thereof in Class 42."

9. Plaintiff's above referenced trademark is hereinafter referred to as "the ONPREM Mark."

10. Plaintiff has been using said mark for over four (4) years and has been

using said markss in interstate commerce since at least that same time.

11. In addition, as a result of Plaintiff's efforts through advertising, promotions, sales, and customer service, as well as favorable recommendations by Plaintiff's customers, Plaintiff's ONPREM services have achieved enormous popularity among the public. As a result of these efforts and Plaintiff's exclusive use of the ONPREM Marks, the ONPREM Marks have acquired substantial goodwill and secondary meaning, serving as an indicator of Plaintiff as the source of origin of its services.

12. By virtue of the ONPREM Mark's inherent distinctiveness and acquired secondary meaning; the long duration and usage exclusively by Plaintiff of the ONPREM Mark the services; Plaintiff's extensive advertising and publicity of the ONPREM Mark; and the extremely high degree of recognition of the mark in the trading areas and channels of trade used by Plaintiff; the ONPREM Mark, is famous under 15 U.S.C. § 1125(c)(1) of the Federal Trademark Dilution Act of 1995.

Defendants' Unlawful Conduct: Trademark Infringement,

Unfair Competition and Trademark Dilution

13. Plaintiff is informed and believes, and on such basis alleges, that Defendant markets and sells technology security services, under the identical name ONPREM.

14. Plaintiff is informed and believes, and on such basis alleges, that

Defendant has advertised its services using the ONPREM mark in national magazines and on the Internet, where consumers confuse its services with Plaintiff's services sold right alongside one another in search results resulting in consumer confusion

15. Defendant has no right, license or other authority from Plaintiff to use any of the ONPREM Marks for any purpose.

16. Plaintiff is informed and believes, and on such basis alleges, that Defendant knew of the ONPREM Mark and that the same was owned by someone other than themselves; knew that the ONPREM Mark was distinctive and famous; and knew that Defendant had not received any authority from Plaintiff to use the ONPREM Mark or any other mark confusingly similar thereto, for any purposes.

17. Defendant's unlawful activities result in irreparable injury and damage to Plaintiff's reputation.

18. Additionally, Defendant's unlawful activities injure the public by depriving the public of the right to be free of confusion in the marketplace.

19. Plaintiff is informed and believes, and on such basis alleges, that Defendant has deliberately, willfully, and maliciously used the ONPREM Mark in order to trade on the goodwill that Plaintiff has attained in the ONPREM Mark, to dilute the ONPREM Mark and to confuse the public into believing that Defendant's unauthorized use is licensed or authorized by Plaintiff.

FIRST CLAIM FOR RELIEF

(Federal Trademark Infringement)

20. This claim for relief arises under 15 U.S.C. § 1114 and is alleged against all Defendants.

21. Plaintiff realleges the allegations in paragraphs 1 through 19 of this Complaint as though fully set forth herein.

22. Plaintiff is the owner of the Federally Registered trademarks, including the ONPREM Mark set forth above. This trademark is inherently distinctive and has, in addition, acquired substantial goodwill and secondary meaning.

23. Plaintiff is informed and believes, and on such basis alleges, that Defendants are using marks confusingly similar or identical to the ONPREM Mark.

24. Defendants have not been authorized by Plaintiff to use any ONPREM Marks or any mark similar thereto, for any purpose whatsoever, including the use of the ONPREM Marks in connection with automotive accessories and goods or services related thereto in any manner.

25. Defendants' unauthorized use of the ONPREM Mark or any mark similar thereto is likely to confuse the public as to the source, origin, sponsorship and affiliation of the goods and services sold by Defendant.

26. Defendants' unauthorized use is likely leading the public to believe Defendants' goods are sponsored by Plaintiff, or with the permission, approval or endorsement of Plaintiff.

27. Defendants' unlawful activities injure the public by depriving the public of the right to be free from confusion in the marketplace.

28. By reason of this unauthorized use of the ONPREM Mark, Defendants have unlawfully and wrongfully derived, and will continue to unlawfully and wrongfully derive, income and profits from these infringing acts, and Plaintiff has sustained, and will continue to sustain, substantial injury, loss and damage in an amount according to proof.

29. Plaintiff is informed and believes, and on such basis alleges, that this infringing use by Defendants has been deliberate and willful, entitling Plaintiff to increased damages and attorney's fees.

30. Plaintiff is informed and believes, and on such basis alleges, unless restrained and enjoined by this Court, Defendants will continue to infringe Plaintiff's trademark rights and cause confusion, deception and mistake among the trade and the consuming public as to the source and sponsorship of the goods and services provided and sold by Defendants.

31. Defendants' activities have caused Plaintiff irreparable injury and unless Defendants' acts are immediately and permanently enjoined, Defendants will continue to use the ONPREM Mark, thus continuing to infringe upon Plaintiff's rights.

32. Plaintiff has no adequate remedy at law.

SECOND CLAIM FOR RELIEF

(California Trademark Infringement)

33. This claim for relief arises under California Business & Professions Code § 14320 and California common law and is alleged against all Defendants.

34. Plaintiff realleges the allegations in paragraphs 21 through 32 of this Complaint as though fully set forth herein.

35. Plaintiff is the owner of common law trademarks and federally registered trademarks, including the ONPREM Mark set forth above. These trademarks are inherently distinctive and have, in addition, acquired substantial goodwill and secondary meaning.

36. Defendants' unauthorized use of marks confusingly similar to the ONPREM Mark is likely to confuse the public as to the source, origin, sponsorship and affiliation of the goods and services sold by Defendants.

37. Defendants have infringed upon Plaintiff's rights by using marks confusingly similar to the ONPREM Mark in connection with their goods well after Plaintiff had used the ONPREM Mark and made them famous.

38. By reason of this unauthorized use of marks confusingly similar to the Plaintiff's Marks, Defendants have unlawfully and wrongfully derived, and will continue to unlawfully and wrongfully derive, income and profits from these infringing acts, and Plaintiff has sustained, and will continue to sustain, substantial injury, loss and damage in an amount according to proof.

39. Plaintiff is informed and believes, and on such basis alleges, that this infringing use by Defendants has been deliberate and willful, entitling Plaintiff to increased damages and attorney's fees.

40. Plaintiff is informed and believes, and on such basis alleges, unless restrained and enjoined by this Court, Defendants will continue to infringe Plaintiff's trademark rights and cause confusion, deception and mistake among the trade and the consuming public as to the source of the services sold by Defendants.

41. Defendants' activities have caused Plaintiff irreparable injury and unless Defendants' acts are immediately and permanently enjoined, Plaintiff will continue to suffer irreparable harm and injury.

42. Plaintiff has no adequate remedy at law.

THIRD CLAIM FOR RELIEF

(Federal Unfair Competition)

43. This claim for relief arises under 15 U.S.C. § 1125(a) and is alleged against all Defendants.

44. Plaintiff realleges the allegations in paragraphs 34 through 42 of this Complaint as though fully set forth herein.

45. As alleged previously, Plaintiff is the owner of the ONPREM Mark, which trademarks have acquired substantial goodwill and secondary meaning.

46. As also alleged above, Defendants have used marks confusingly similar to the ONPREM Mark in connection with Defendants' services without

permission or authority from Plaintiff.

47. Defendants have not obtained from Plaintiff any license or other permission to use any of the ONPREM Mark or marks confusingly similar thereto for any purpose whatsoever.

48. Defendants' unauthorized use and registration of marks confusingly similar to the ONPREM Mark, constitutes a false designation of origin and false or misleading representation of fact, which is likely to cause confusion, mistake, or to deceive customers and potential customers as to the source, origin, sponsorship and affiliation of the services sold by Defendants.

49. Defendants' above-mentioned use and registration of the ONPREM Mark, and marks confusingly similar thereto constitute violations of Section 43(a) of the Lanham Act (15 U.S.C. § 1125(a)).

50. Defendants have unlawfully and wrongfully derived, and will continue to unlawfully and wrongfully derive, income and profits from these acts of false designation of origin and false representation, and Plaintiff has sustained, and will continue to sustain, substantial injury, loss and damage in an amount to be proven at trial.

51. Defendants' activities have caused Plaintiff irreparable injury and unless Defendants' acts are immediately and permanently enjoined, Plaintiff will continue to suffer irreparable harm and injury.

52. Plaintiff has no adequate remedy at law.

FOURTH CLAIM FOR RELIEF

(California Unfair Competition)

53. This claim for relief arises under the California Business & Professions Code §§17200, *et seq*. and 17500 and is alleged against all Defendants.

54. Plaintiff realleges the allegations in paragraphs 44 through 52 of this Complaint as though fully set forth herein.

55. Defendants' conduct is unfair and deceptive behavior pursued in the course of their businesses in that their actions were likely to deceive present and potential customers of Defendants and of Plaintiff.

56. Defendants have willfully decided to unfairly compete with Plaintiff by misappropriating Plaintiff's proprietary Mark by unlawfully using a mark confusingly similar to Plaintiff's proprietary mark in an attempt to trade on Plaintiff's goodwill and confuse consumers as to the source, origin, sponsorship and affiliation of the services sold by Defendants.

57. Defendants have unlawfully derived income and profits from their activities and will continue to so derive income and profits from their acts of unfair competition, and Plaintiff has sustained, and will continue to sustain, substantial injury, loss and damage in an amount according to proof.

58. Defendants' activities have caused Plaintiff irreparable injury and unless Defendants' acts are immediately and permanently enjoined, Plaintiff will continue to suffer irreparable harm and injury.

59. Plaintiff has no adequate remedy at law.

FIFTH CLAIM FOR RELIEF

(Federal Trademark Dilution)

60. This claim for relief arises under 15 U.S.C. §1125(c) and is alleged against all Defendants.

61. Plaintiff realleges the allegations in paragraphs 54 through 59 of this Complaint as though fully set forth herein.

62. Plaintiff is the owner of the ONPREM Mark, set forth above. These trademarks are inherently distinctive, have acquired substantial goodwill and secondary meaning, and are famous within the meaning of 15 U.S.C. § 1125(c)(1) of the Federal Trademark Dilution Act of 1995.

63. Defendants are using marks confusingly similar to the ONPREM Mark without authorization from Plaintiff in connection with the automotive products.

64. Defendants have not been authorized by Plaintiff to use any of the ONPREM Marks or any marks confusingly similar thereto for any purpose whatsoever, including the sale of with technology security services.

65. Defendants' use of marks confusingly similar to the ONPREM Mark dilutes the marks by lessening their capacity to identify and distinguish Plaintiff's services in the stream of commerce.

66. Defendants' use of marks confusingly similar to the ONPREM Mark occurred only after the marks had become famous.

67. By reason of this unauthorized use of marks confusingly similar to the ONPREM Mark, Defendants have unlawfully and wrongfully derived, and will continue to unlawfully and wrongfully derive, income and profits from these diluting acts, and Plaintiff has sustained, and will continue to sustain, substantial injury, loss and damage in an amount according to proof.

68. Plaintiff is informed and believes, and on such basis alleges that, through this use, Defendants deliberately and willfully intended to trade on the goodwill that Plaintiff has attained in the ONPREM Mark and to cause dilution of the ONPREM Mark, entitling Plaintiff to increased damages and attorney's fees.

69. Plaintiff is informed and believes, and on such basis alleges that, unless restrained and enjoined by this Court, Defendants will continue to use marks confusingly similar to the ONPREM Mark, thus continuing to cause the dilution of the ONPREM Mark.

70. Defendants' activities have caused Plaintiff irreparable injury and unless Defendants' acts are immediately and permanently enjoined, Plaintiff will continue to suffer irreparable harm and injury.

71. Plaintiff has no adequate remedy at law.

SIXTH CLAIM OF RELIEF

(California Trademark Dilution)

72. This claim for relief arises under California Business & Professions Code § 14330, and is alleged against all Defendants.

73. Plaintiff realleges the allegations of paragraphs 61 through 71 of this Complaint as though fully set forth herein.

74. Plaintiff is the owner of common law trademarks, trademarks registered in the state of California, and federally registered trademarks, including the ONPREM Mark set forth above. These trademarks are inherently distinctive and have, in addition, acquired substantial goodwill and secondary meaning and well known and famous.

75. Plaintiff is informed and believes, and on such basis alleges that Defendants, with full knowledge of the public recognition of the ONPREM Mark, have used marks confusingly similar to the ONPREM Mark on their services without authorization from Plaintiff after Plaintiff's marks became well known and famous.

76. The aforementioned actions of Defendants have caused, and are likely to continue to cause, injury to Plaintiff's business and professional reputation and to dilute the distinctive quality of the ONPREM Mark in violation of Section 14330 of the California Business & Professions Code.

77. Defendants' activities have caused Plaintiff irreparable injury and unless Defendants' acts are immediately and permanently enjoined, Plaintiff will continue to suffer irreparable harm and injury.

78. Plaintiff has no adequate remedy at law.

WHEREFORE, Plaintiff prays for judgment against Defendants as follows:

1. That the Court issue a preliminary injunction restraining, enjoining and prohibiting Defendants, and their officers, agents, employees and attorneys, and any person in active concert or participation with them or who are acting under their direction, and each of them, from the following:

(a) diluting the ONPREM Mark and damaging Plaintiff's goodwill, reputation and business related thereto,

(b) using the ONPREM Mark in any manner, and from causing, contributing to or participating in, the unauthorized display and/or distribution of the ONPREM Mark to the public in connection with any service or product,

(c) engaging in conduct which tends falsely to represent or is likely to confuse, mislead or deceive members of the public,

(d) Otherwise unfairly competing with Plaintiff in any manner, and

(e) Continuing to perform in any manner whatsoever any of the other acts complained of in this Complaint;

2. That this Court issue a permanent injunction, prohibiting Defendants from directly or indirectly diluting or infringing the ONPREM Mark, and in any manner unfairly competing with Plaintiff; and from inducing, or contributing to or participating in any such acts referred to in paragraph 1 of this prayer;

3. That the Court award Plaintiff its damages from Defendants including recovery of any compensatory damages sustained by Plaintiff as a result of Defendants' diluting, infringing and/or tortuous activities described herein;

4. That the Court order Defendants to account for all gains, profits and advances derived by Defendants from the acts complained of, together with appropriate interest thereon;

5. That the Court further award Plaintiff an increase in damages in an amount found or assessed as a result of willful acts of trademark dilution, trademark infringement, and unfair competition under 15 U.S.C. § 1117;

6. That Defendants pay Plaintiff's costs and disbursements in this action, together with reasonable attorneys' fees;

7. That Plaintiff be awarded punitive damages; and

8. That Plaintiff have such other and further relief as the Court may deem just and proper.

DATED: May 16, 2017

FISCHBACH, PERLSTEIN, LIEBERMAN & ALMOND, LLP

By: ______________________

Michael P. Martin
Attorneys for Plaintiff, OnPrem Solution Partners, LLC